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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,036	03/19/2004	Kia Silverbrook	ZG122US	7058
24011 7590 06/24/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
HO, TUAN V				
ART UNIT		PAPER NUMBER		
2622				
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06/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,036

Applicant(s)

SILVERBROOK, KIA

Examiner

Tuan V. Ho

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. It should be noted that the Terminal Disclaimer filed 4/11/08 has been approved. Therefore, the Double patenting rejections are withdrawn.

2. Applicant's arguments filed 4/11/08 have been fully considered but they are not persuasive because:

Applicant argues that the reference does not disclose "one time use, disposable devices, let alone a one-time use, disposable postcard generator", page 5, last paragraph of the remarks. In response to the arguments the examiner notes that the claimed disposable postcard in claim 1 is new matter since the specification does not disclose any disposable postcard. It is noted that the summary of the invention suggest the concept of a single use disposable camera; however, the specification does not disclose how the post card that can be one-time use and disposable.

The rejections are repeated as best understood.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "A one-time use, disposable postcard generator" in claim 1 and "a disposable casing" in claim 10 is new matter since the specification does not disclose the features.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 5,847,836) in view of Barber (US 5,343,386).

With regard to claim 1, Suzuki discloses in Fig. 1, a printer built-in video camera that comprises print generator (printer engine 52, col. 6, line 35-36; It is noted that claimed "one-time use, disposable" is not given patentable weight since the terms is in the preamble and the body of the claim does not have any features to support it; and the term is considered as a field of use of the device) comprising an image sensor device for capturing an image (CCD 40, col. 5, line 55) and an image processor for processing a captured image (image processor, col. 6, lines 20-62); and a pagewidth printhead configured to print a captured (ink-jet head 5, col. 6, line 4; it should be noted that the head 5 can print the whole page width) and the processed image on a first side of print media (printer 52 can print an image on one side as shown in Fig. 1), except for to print a postcard format onto a second side of said print media.

Suzuki does not explicitly disclose any a postcard format onto a second side of said print media. However, Barber teaches using printing sheets of paper in a video postcard system, that include a plurality of formatted postcard information including pre-printed postage, address and message on the opposite side of

the image side for immediate mailing (col. 2, line 20 and col. 3, lines 3-12). It is noted that postcard information preprinted in the back surface of a printed paper correspond to an object image that is selected by a user so as to be immediately mailed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the print roll of Suzuki in the same fashion as disclosed by Barber so as to obtain a plurality of formatted postcard information pre-printed on the back surface of the print roll for immediate mailing after printing and thereby conveniently to mail an postcard without going to a post office for a postage and thereby to improve the camera versatility.

With regard to claims 2 and 3, Furthermore, Barber discloses a token indicating that postage has been paid, said token being printed onto said print media by said printhead (Barber discloses in col. 2, lines 19+ that postage is for immediately mailing; as a result, a token is inherently printed on the postcard so as to mail).

With regard to claim 4, Furthermore, Barber discloses tokens pre-marked indicating that postages are paid for immediately mailing (col. 2, lines 19+).

With regard to claim 5, tokens are printed are pre-printed at regularly spaced intervals the surface of the print media

adapted to receive the postcard format thereon, the spacing being substantially equal to the size of the printed image to be printed on the other side of the print media (the postcard information is inherently pre-printed in a predetermined interval on the back surface of the print roll; where the postcard information corresponds to an object image selected to be printed on the front surface of the print roll. Otherwise, a user cannot mail the post card because of missing the postcard information).

With regard to claim 6, Barber discloses the postcard format includes an address zone (An address zone is inherently included in the postcard; where the address zone is used to show an address of a receiver).

With regard to claim 7, Barber discloses the postcard format includes a blank zone (a blank zone inherently included in the postcard since it used to hold an address).

With regard to claim 8, Suzuki in view of Barber does not disclose any memory for storing the postcard format.

Official Notice is taken for a memory is used to hold a postcard format so as to provide different printed postcards. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the memory 56 of Suzuki so as to store postcard formats because the

storage of postcard formats would allow a user to print different postcards at different scenes and thereby to improve camera efficiency.

With regard to claim 9, Suzuki discloses the guillotine adapted to separate a printed postcard from the print roll (cutter 42, col. 8, line 10).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Ho

whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri 7:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan V Ho/

Primary Examiner, Art Unit 2622